

Serial No.: 10/728,439

Confirmation No.: 9418

Filed: 5 December 2003

For: POLYMER COMPOSITIONS WITH BIOACTIVE AGENT, MEDICAL ARTICLES, AND METHODS

Remarks

The Office Action mailed July 19, 2007, has been received and reviewed. Claims 1, 3, 7, 13, 19, 27, 46, 47, 53, 55, 62, 66, 70, 73, 75, 76, and 84 having been amended, claims 11, 51, 52, 56, and 57 having been cancelled, the pending claims are claims 1-10, 12-50, 53-55, and 58-93.

Support for the amendments to the claims can be found in the specification as filed and the originally filed claims (e.g., claim 51). No new matter has been added.

Reconsideration and withdrawal of the rejections are respectfully requested.

Obviousness-Type Double Patenting and 35 U.S.C. §103(a) Rejection

The Examiner provisionally rejects claims 1-10, 12, 19-51, 53-55, 58-60, 75, 88, and 89 under the doctrine of obviousness-type double patenting over claims 1-15, 19-21, 26-39, 40-46, 49, 51, 53-63 and 70 of co-pending Application No. 10/728,577 (published as US 2004/0180093) alone or in view of Laurin et al. (US 4,603,152). Applicants respectfully submit that Application No. 10/728,577 is commonly owned. Upon the identification of otherwise allowable subject matter, Applicants reserve their right to argue the patentable distinctness of the claims over co-assigned Application No. 10/728,577 (published as US 2004/0180093) alone or in view of Laurin, or alternatively offer a terminal disclaimer to cure any remaining obviousness-type double patenting rejections.

The Examiner further states that claims 1-10, 12, 19-51, 53-55, 58-60, 75, and 89 are rejected under 35 U.S.C. §103(a) over commonly assigned co-pending Application No. 10/728,577 (published as US 2004/0180093). Clarification of this rejection is requested. It is respectfully submitted that the present application was filed on the same date as US 2004/0180093, although US 2004/0180093 is a continuation-in-part of an earlier application. For Applicants to properly respond to this rejection, the Examiner is requested to clarify the rejection by identifying the relevant portions of US 2004/0180093.

The 35 U.S.C. §112, Second Paragraph, Rejection

Claims 46-47 are rejected under 35 USC 112, second paragraph, as being indefinite. Although Applicants do not agree with the Examiner, Applicants have amended the claims according to the Examiner's suggestion, solely in the interest of expediting prosecution.

The 35 U.S.C. §103 Rejections

Claims 1-4, 6-9, 12, 19-39, 42-45, 48, 49, 50, 53, 55, 58-60, 75 and 89 are rejected under 35 USC 103(a) as being obvious over Asmus (US 5,270,358) alone or in view of Laurin et al. (US 4,603,152). Claims 5, 10, 40 and 41 are additionally rejected under 35 USC 103(a) as being obvious over Asmus (US 5,270,358) alone or in view of Laurin et al. (US 4,603,152) and further in view of Ahmed et al. (US 6,458,877). Claims 13-18, 84-87 and 92 are additionally rejected under 35 USC 103(a) as being obvious over Asmus (US 5,270,358) alone or in view of Laurin et al. (US 4,603,152) and further in view of Yan et al. (US 2003/0185889). Claims 62, 64-66, 70, 72-74, 76-78 and 80-83 are rejected under 35 USC 103(a) as being obvious over Asmus (US 5,270,358) alone or in view of Laurin et al. (US 4,603,152) and further in view of Boa et al. (CN 1308102, abstract). Claim 79 is rejected under 35 USC 103(a) as being obvious over Asmus (US 5,270,358) alone or in view of Laurin et al. (US 4,603,152) and further in view of Boa et al. (CN 1308102, abstract) and Ahmed et al. (US 6,458,877). Claims 63 and 71 are rejected under 35 USC 103(a) as being obvious over Asmus (US 5,270,358) alone or in view of Laurin et al. (US 4,603,152) and further in view of Bao et al. (CN 1308102, abstract) and Antelman (US 6,436,420). These rejections are respectfully traversed.

It is noted that claim 51 has not been included in any of these rejections. Accordingly, the language of claim 51 (the hydrophobic polymer forms a continuous phase) has been incorporated into claim 27 and the other independent composition claims.

With respect to the method claims, it is respectfully submitted that there is no teaching or suggestion of Applicants' claims in any of the cited document used in any combination. There is no teaching or suggestion of techniques for dispersing a metal oxide within a hydrophilic

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polymer, e.g., through the use of a hydroxide source or ammonia source.

As Applicants describe in the Specification beginning with the paragraph on page 12, line 6:

Substantially all of the dispersed silver, zinc, and copper compounds have an average particle size less than 1 micron in size. By utilizing a process that solubilizes the metal compound, either through use of a soluble metal compound that is converted in-situ to the corresponding metal oxide with a hydroxide source, or by complexing the metal oxide using an ammonia source in situ, the resulting dispersed metal oxides form particles within the hydrophilic polymer. Average particles sizes less than 1 micron are provided in part by the tendency of the metal oxide to form a complex with the hydrophilic polymer. The small particle size allows accelerated dissolution based on the high surface area to mass ratio of the particle. [emphasis added]

Asmus makes no disclosure regarding the silver oxide particle size, or whether it is dispersed within a hydrophilic polymer, or how to get the metal oxide dispersed within a hydrophilic polymer. For example, Asmus provides no disclosure of adding a hydroxide source or an ammonia source to accomplish the dispersion of the silver oxide. Furthermore, Applicants' disclosure cannot be used in hindsight to provide the motivation to modify Asmus. Withdrawal of the rejections is respectfully requested.

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Summary

It is respectfully submitted that the pending claims 1-10, 12-50, 53-55, and 58-93 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

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The undersigned hereby certifies that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to **Mail Stop RCE**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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